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OFFICE OF PETITIONS

In re Application of
Frazzitta, et al.
Application No. 08/889,033
Filed: July 7, 1997
Docket No.: D-1083
For: Transaction System

DECISION ON PETITION

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Petition Under 37 CFR 1.181," received on September 23, 2010. The petition is being treated under 37 CFR 1.181 and 37 CFR 1.701, as a petition for patent term extension.

The petition is granted.

Petitioner asserts the application is entitled to patent term extension under 35 U.S.C. 154. Petitioner asserts that the application was filed on July 7, 1997 and allowed on July 15, 2010, but issuance was delayed due to two appeals to the Board of Patent Appeals and Interferences (BPAI). Petitioner states that the USPTO failed to provide patent term extension for both of the appeals in the Notice of Allowance. Petitioner notes that the application was filed on July 7, 1997 and is eligible for patent term extension under 35 U.S.C. 154 and 37 CFR 1.701.

On July 7, 1997, the above identified application was filed.

On October 5, 2000, a Notice of Appeal was filed.

On July 21, 2005, a Decision by the BPAI reversing the decision of the Examiner and remanding the application to the Examiner was mailed by the Office.

On January 26, 2006, a Notice of Appeal was filed.

On September 21, 2007, a Decision by the BPAI reversing the decision of the Examiner was mailed by the Office.

35 U.S.C. § 154(b) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for those delays and others in applications filed on or after May 29, 2000.

The above-identified application was filed on July 7, 1997. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995.

A Notice of Appeal was filed in the above-identified application on October 5, 2000. On July 21, 2005, the Board of Patent Appeals and Interferences (BPAI) reversed an adverse determination of patentability by the examiner in the above-identified application. Since the above-identified application was filed after June 7, 1995, there is no terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review, and issuance of the application as a patent was delayed due to appellate review resulting in reversal of an adverse determination by the Examiner, the patent to issue from the application is entitled to an extension of the patent term. The period of delay in the above-identified application is the period beginning on October 5, 2000, the date that the Notice of Appeal was filed and ending on July 21, 2005, the date of the decision by the BPAI, which is a final decision in favor of the applicant. Three years after the earliest effective filing date of the application is July 7, 2000. Accordingly, the period of extension is not required to be reduced pursuant to 37 CFR 1.701(d)(1) by the amount of time prior to three years after the filing date of the application. As a result, the first period of extension is 1386 days, the period from October 5, 2000 to July 21, 2005, including the beginning and end dates.

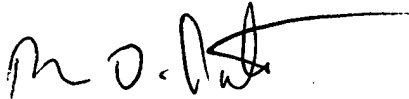
A second Notice of Appeal was filed in the above-identified application on January 26, 2006. On September 21, 2007, the Board of Patent Appeals and Interferences (BPAI) reversed an adverse determination of patentability by the examiner in the above-identified application. Since the above-identified application was filed after June 7, 1995, there is no terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review, and issuance of the application as a patent was delayed due to appellate review resulting in reversal of an adverse determination by the Examiner, the patent to issue from the application is entitled to an extension of the patent term. The second period of delay in the above-identified application is the period beginning on January 26, 2006, the date that the Notice of Appeal was filed and ending on September 21, 2007, the date of the decision by the BPAI, which is a final decision in favor of the applicant. Three years after the earliest effective filing date of the application is July 7, 2000. Accordingly, the period of extension is not required to be reduced pursuant to 37 CFR 1.701(d)(1) by the amount of time prior to three years after the filing date of the application. As a result, the first period of extension is 604 days, the period from January 26, 2006, to September 21, 2007, including the beginning and end dates.

As a result, the period of extension is 1990 days. In accordance with 37 CFR 1.701(b), the term of a patent under this section may be extended up to a maximum of five years. The patent term extension under 35 U.S.C. 154 and 37 CFR 1.701 is five (5) years or 1,826 days.

The Office's electronic record (Patent Application and Location Monitoring system (PALM)) will be adjusted to show that five (5) years of patent term extension has been accrued to the above-identified application.

Petitioner's deposit account has not been charged a petition fee.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.

A handwritten signature in black ink, appearing to read 'M. O. Polutta', with a long horizontal stroke extending to the right.

Mark Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy